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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,413	10/25/2004	Seiji Kagawa	KAGAWA I	6666
1444 7590 09/14/2007 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			EXAMINER O HERN, BRENT T	
			ART UNIT 1772	PAPER NUMBER
			MAIL DATE 09/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/512,413	Applicant(s) KAGAWA ET AL.	
	Examiner Brent T. O'Hern	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 11-35, 38-65, 67, 68, 73 and 74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 63, 67, 68, 73 and 74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 July 2007 has been entered.

Claims

2. Claims 6, 11-35, 38-65, 67-68 and 73-74 are pending with claims 11-35, 38-62, and 64-65 withdrawn.

WITHDRAWN REJECTIONS

3. The 35 U.S.C. 102 (b) rejections of claims 1 and 6-8 as being anticipated by Littmann et al. (US 5,512,337) of record in the Office Action mailed 11 January 2007, page 3, paragraph 6 have been withdrawn due to Applicant's amendments in the Paper filed 27 August 2007.

4. The 35 U.S.C. 102 (b) rejections of claims 1, 7-8 and 66-72 as being anticipated by Kai (US 4,543,279) of record in the Office Action mailed 11 January 2007, page 5, paragraph 7 have been withdrawn due to Applicant's amendments in the Paper filed 27 August 2007.

NEW REJECTIONS

Claim Rejections - 35 USC § 112

5. Claims 73-74, 6, 63 and 67-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

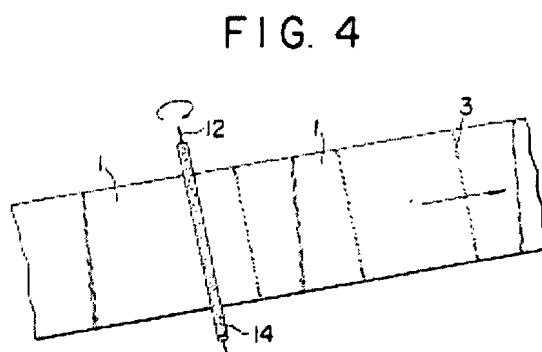
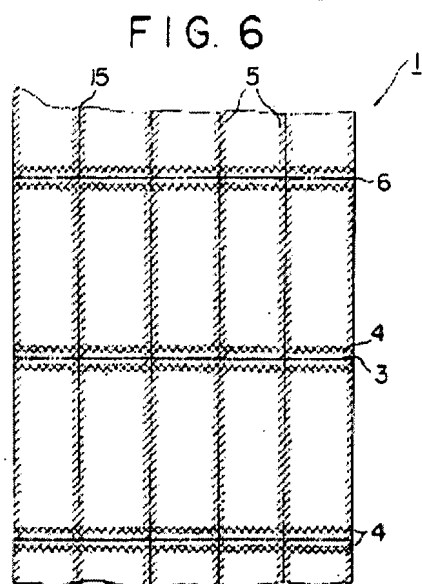
6. The phrase "said linear scratches being as small as 0.1 to 10 μm in depth and 0.1 to 10 μm in width" in claim 73, lines 7-9 and claim 74, lines 8-10 is vague and indefinite since it is unclear how scratches can be "as small as" 0.1 μm and 10 μm at the same time. Furthermore, the above values are an impermissible range within a range since said phrases provides for a range and a value within the range. Thus, it is unclear what definite value or arrange Applicant wants to claim.

Clarification and/or correction is required.

7. Claims 73-74, 6, and 67-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Kai (US 4,543,279).

Regarding claims 73 and 67-68, Kai ('279) teaches a tearable thermoplastic resin film (See col. 3, ll. 20-28.) having a plurality of greater than six substantially parallel linear scratches spaced apart at the same interval over an entire width of the film, and the linear scratches being spaced apart at intervals of 10 to 200 μm (See FIGs 6 and 4, #3 and col. 3, ll. 53-58 wherein more than 100 scratches per centimeter are spaced across the width of the structure, thus, an interval of 100 μm .).

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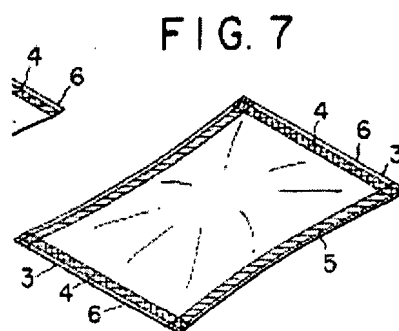
The phrases "said linear scratches being formed by sliding contact with a rotating roll having fine hard particles with sharp edges over the entire surface of the rotating roll" in claim 73, lines 4-7 and claim 74, lines 6-8, "wherein said fine particles have a Mohs' hardness of 5 or more" in claim 67, lines 2-3, and "wherein said fine particles are fine diamond particles" in claim 68, lines 2-3 are **process limitations** in product claims and hence not given any patentable weight since patentability of a product does not depend on its method of production (see *MPEP* § 2173.05(p)).

The phrase "so that said film is easily torn straight from any point along said linear scratches" in claim 73, lines 9-11 and claim 74, lines 10-12 are deemed to be a

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statements with regard to the **intended use** and is not further limiting in so far as the structure is concerned (see *MPEP 2111.02*).

Regarding claim 74, Kai ('279) teaches a tearable thermoplastic resin film and a sealant film layer, the tearable thermoplastic resin film having a plurality of greater than six substantially parallel linear scratches spaced apart at a same interval over an entire width of the film (See *FIGs 6-7, col. 3, ll. 53-58 and col. 5, ll. 42-28 wherein the sheet is transformed into bags with multiple layers, with at least one layer functioning as a sealant layer, and can be torn.*).



Regarding claim 6, Kai ('279) teaches a film further having a plurality of uniformly located non-penetrating pores (See *FIGs 6-7 wherein the pores are formed by the inner volume of the container.*).

Claim Rejections - 35 USC § 103

8. Claims 6 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kai (US 4,543,279) in view of Littmann et al. (US 5,512,337).

Regarding claim 6, Kai ('279) teaches the film with scratches as discussed above, however, fails to expressly disclose further having a multiplicity of uniformly located penetrating pores and an average opening diameter of 0.5 to 100 μm (col. 5, l. 56 – col. 6, l. 7).

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However, Littmann ('337) teaches further having a multiplicity of uniformly located penetrating pores (*col. 5, l. 56 – col. 6, l. 7*) for the purpose of providing a structure that is easy to tear (*col. 6, ll. 1-7*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to substitute Kai's ('279) scratches by the pores of Littmann ('337) in order to provide a structure that is easy to tear.

Regarding claim 63, Kai ('279) teaches the film discussed above, however, fails to expressly disclose wherein the fine pores have an average opening diameter of 0.5 to 100 μm .

However, Kai ('279) teaches wherein the depth of the scratches/holes is determined by the particle size of the grains on the abrasive (*col. 3, l. 66 to col. 4, l. 7*), are shallow enough to be invisible to the naked eye (*col. 3, ll. 28-34*) and wherein the width and depth of the scratches/holes arranged linearly vary depending on the kind and thickness of the sheet to be used (*col. 3, ll. 63-58*) for the purpose of providing a film that can easily be torn without changing the product (*col. 3, ll. 43-52*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to modify Kai's ('279) film with pores with the above dimensions in order to provide a film that can easily be torn without changing the product.

ANSWERS TO APPLICANT'S ARGUMENTS

9. In response to Applicant's argument (*p. 27, para. 2 to p. 28, para. 1 of Applicant's Paper filed 11 July 2007*) that the references do not teach the new limitations, it is noted that said limitations are discussed above.

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Conclusion

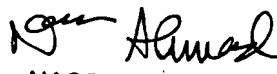
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent T. O'Hern whose telephone number is (571) 272-0496. The examiner can normally be reached on M-Th, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Brent T O'Hern
Examiner
Art Unit 1772
September 9, 2007



NASSER AHMAD
PRIMARY EXAMINER

9/12/07